

AMENDMENT UNDER 37 C.F.R. § 1.116  
U. S. Application No. 09/834,942

**REMARKS**

Claims 1-6, and 9 are pending in the application. By this Amendment, claims 7 and 8 are cancelled. Claim 9 is objected to under 37 C.F.R. § 1.75(c) as being of improper dependent form. Claim 7 is rejected under 35 U.S.C. § 112, first paragraph and claims 7-9 are rejected under 35 U.S.C. § 112, second paragraph. Claims 1, 2, 4, 5/4, 5/2, 3, 5/3, and 5/1 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fender et al. (U.S. Patent No. 5,300,784A) (“Fender”) in view of Tonami et al. (JP 8-306328 A) (“Tonami”). Claims 6/4, 6/2, 6/3, and 6/1 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Fender and Tonami as applied to claims 4, 2, 3, and 1 above, and further in view of Letter (U.S. Patent No. 3,556,787A) (“Letter”). Applicant submits the following changes to the claims and arguments to traverse the prior art rejections.

Applicant’s invention relates to a planar electrostatic recording material. Applicant refers the Examiner to the detailed description of an embodiment of the invention, and the cited references in the February 26, 2003 Amendment, pages 7-9.

With regard to the objection to claim 9, Applicant submits that the amended claim obviates the objection. The claim further limits claim 1 by specifically describing a base plate disposed towards the side opposite to the surface of the flat plate-shaped substrate, on which surface the electrostatic recording material is formed.

Claims 1, 2, 4, 5/4, 5/2, 3, 5/3, and 5/1 are rejected under § 103(a) as being unpatentable over Fender in view of Tonami. Applicant submits that the Examiner has not established a prima facie case of obviousness for the claims. Nowhere in the combination of Fender and Tonami is there any teaching of a base plate and a substrate as recited in claim 1. In claim 1, the flat plate-

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shaped substrate and the base both “support the electrostatic recording material from” the read-out side of the electrostatic recording material. The Examiner has not taken into account both aspects of the orientation of the base plate in the rebuttal. The Examiner only focuses on the orientation of the base plate and medium. Detailed Action, pg. 7, first full paragraph. At no point does the Examiner consider the disposition of the base plate relative to the read-out direction in the rebuttal. This is the reason the rejection cannot be maintained. The Examiner essentially contends that this orientation for the read-out orientation, is implicit in claim 1. Page 2, paragraph 1. The Examiner cannot maintain that claim 1 doesn't include the feature regarding the read-out orientation and at the same time maintain that claim 9 does not further limit claim 1. Therefore, either claim 1 is patentable based on the recited orientation relative to a read-out direction or claim 9 is patentable relative to the base plate orientation relative to the read-out direction. According to FIGS. 1-5 of Tonami, however, the glass thin plate 22 characterized by the Examiner as being analogous to the substrate of claim 1, supports the amorphous selenium film 23 from the recording side (direction indicated by parallel arrows in FIG. 1) and nothing is shown to support the selenium film 23 from the read out side (indicated by the dotted arrow labeled “-e”). In other words, Tonami fails to disclose the interrelationship of the electrostatic recording material, the flat plate-shaped substrate, and the flat plate-shaped base plate with respect to a read-out surface.

Assuming arguendo, that the Examiner is correct in that Tonami discloses a flat plate-shaped base plate 21 for the purpose of enhancing mechanical strength, the Examiner has not put forward a valid suggestion or motivation for one skilled in the art to modify the imaging apparatus of Fender to include the glass plate 21, originally disposed at the recording side in

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Tonami, at the read-out side of the apparatus of Fender (below the transparent surface 11). To the contrary, Fender does not disclose a suggestion or provide motivation for enhancing mechanical strength but discloses a photoreceptor and substrate combination for longer life and increased charging potential for greater x-ray sensitivity and image quality (col. 3, lines 51-54).

Applicant also submits that the Examiner has failed to address how “the flat plate-shaped base plate having a rigidity higher than the rigidity of the substrate and *having permeability* with respect to the reading electromagnetic wave,” is taught or suggested by the references. Even if Tonami discloses a member which is a counterpart of the base plate of the present invention, Tonami’s teachings, in combination with Fender, fail to teach, suggest, or provide motivation for and is irrelevant to the claimed base plate from the view point of the fact that that the base plate has permeability to a reading electromagnetic wave, since Tonami does not disclose the use the reading electromagnetic wave.

Further, Applicant submits that “a side opposite to a surface of the substrate, on which surface the electrostatic recording material is formed” as recited in the claim, refers to the side of the surface of the substrate upon which surface the reading electromagnetic wave impinges. Consequently, even if Tonami teaches a member which is a counterpart of the claimed base plate, there is still no teaching, suggestion, or motivation from the teachings of Tonami to render claim 1 obvious, wherein the base plate for supporting the substrate from a side opposite to a surface of the substrate, on which surface the electromagnetic recording material is formed, is provided, since Tonami does not disclose the use of the claimed electromagnetic wave.

Furthermore, Tonami and Fender teach away from the claimed combination because of the inoperative combination of glass plate 21 of Tonami and the raster grid scanning technique of

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Fender. In Fender, the photoreceptor is scanned in a raster grid pattern through the transparent back surface (col. 5, lines 59-61) to form a pixel map (col. 6, line 5). If the Examiner is correct in his characterization of the glass plate 21 of Tonami as being "thicker" (page 4) than a substrate to support the same, then the necessary thickness would prevent the accurate measurement of the pixel map for the photoreceptor in Fender. The thickness of the base plate would induce a refraction of the laser light source as it travels through the surfaces of the thick base plate, making it difficult to accurately determine the location where the laser light hits the photoreceptor, assuming *arguendo*, that the base plate has permeability with respect to the reading electromagnetic wave. The refraction of the laser light would be worse when the laser light source scans portions of the photoreceptor far from the position of the laser. The high angle of incidence and the resulting large refraction of the laser would arguably make it difficult to control where the laser impinges on the photoreceptor to form a high resolution raster pattern digital read out of the image. Thus, Applicant submits that one skilled in the art would not be led to combine Tonami and Fender to render claim 1 obvious.

The Examiner contends that the claimed relative rigidity is a necessary feature due to relative thickness. However, factors other than thickness, such as composite materials of respective glass layers also dictate rigidity, and the Examiner is speculating that the rigidity is met.

Claims 2, 4, 5/4, 5/2, 3, 5/3, and 5/1, which depend from claim 1, are believed to be patentable at least by virtue of their dependency.

Claims 6/4, 6/2, 6/3, and 6/1 are rejected under § 103(a) as being unpatentable over Fender and Tonami as applied to claims 4, 2, 3, and 1 above, and further in view of Letter.

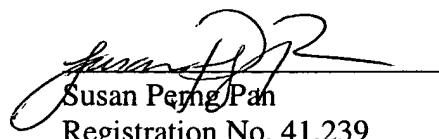
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Applicant submits that the Examiner has improperly combined the references and that the claims are patentable. While Letter suggests the use of an anti-reflecting film, Letter suggests its use for coating the bombarded film (col. 3, lines 55-56). Nowhere in any of the references, individually, or combined, is there any suggestion to forming an anti-reflection coating layer formed on a light entry face of the base plate.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Susan Peing Pan  
Registration No. 41,239

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE



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